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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,798	01/22/2002	T. Edward Black		8658

7590 09/17/2003

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EXAMINER

VANAMAN, FRANK BENNETT

ART UNIT PAPER NUMBER

3618

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/051,798	BLACK, T. EDWARD
	Examiner Frank Vanaman	Art Unit 3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 3/27/03.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on 24 February 2003 is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

### Drawings

1. The amendment filed Feb. 24, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the added views 2, 3, 4 and 5 of the drawings.

Applicant is required to cancel the new matter in the reply to this Office Action.

### Specification

2. The substitute specification filed with the amendment of Feb. 24, 2003 has not been entered because it is not accompanied by a marked-up copy of the original specification showing the changes which have been made. A substitute specification must be accompanied by a marked-up copy showing all changes from the previous specification. All further references to the specification are to the specification as originally filed.

3. The disclosure is objected to because of the following informalities: In the specification, numerous sheets have been dedicated to the 'Personal Capabilities and Expertise Prospectus' of the inventor. This is not appropriate material for a patent specification in that it does not describe the invention. The specification should consist of a description of the invention, which should be as short and specific as is necessary to describe the invention adequately and accurately. In the specification, the various reference numerals or letters used in the drawings are not identified. It is preferable that the portion of the specification describing an element or elements shown in the drawings include the reference numeral or letter which is used in the drawings to identify that element. At page 2, line 9 of the originally filed specification, the term 'quadisc' is not clear.

Appropriate correction is required.

4. The abstract of the disclosure is objected to because it lacks a concise description of the *structure* of the invention. Correction is required. See MPEP § 608.01(b) which sets forth the requirements of an abstract of the disclosure.

5. The title of the invention is too long. A new, concise, title is required that is clearly indicative of the invention to which the claims are directed.
6. The following title is suggested: Frame for Wheeled Skates.

#### **Claim Rejections - 35 USC § 112**

7. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, lines 4-5, the claim refers to various terrain dictated diameters, however the claim nor the specification as originally filed fail to describe how the diameters of the discs may be dictated by terrain; in line 14, the claim refers to a nonpedal input motivating surface, however the specification as filed fails to describe such a surface.
8. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In lines 3-4, it is not clear whether the two named groups of discs ("rotating discs"; "a row of rotating discs") refer to the same or different elements concurrently; in line 12, it is not clear whether or not the limitations following "has capability for" are being positively claimed; in line 13, the use of "i.e. boots, sandals, shoes, ... etc" renders the claim indefinite in that the claim includes elements not actually disclosed (those encompassed by "... etc"), thereby rendering the scope of the claim(s) unascertainable; further, the use of "i.e." implies a range within a range—the larger range encompassing "external pedal equipment", the narrower range encompassing "boots, sandals, shoes, ... etc.", clouding the determination of which of these ranges is desired for coverage, in line 14, it is not clear what is meant by a "nonpedal input motivating surface".

9. The claim is narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

### **Claim Rejections - 35 USC § 102**

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated, as best understood, by Chen (US 5,474,310). Chen teaches a structurally sound skate frame which provides integrity for a plurality of discs (5) at constant elevations (figure 1), including dual parallel planar sides and an orthogonal top (frame elements 4) connecting the sides along their top-most edges, the sides including mountings for the ends of wheel-axle shafts (6, 61, 62) including integral rotational locking geometry (41, figure 1), the top including the capability of allowing additional equipment to be attached (note mounting portion illustrated in figure 1); the dual parallel elements providing a mounting provision (shown left-most in figure 1) at one longitudinal extreme of the frame, for accommodating a brake device.

As regards the provision of terrain selected disc diameters, the examiner notes that the reference of Chen is inherently capable of accommodating wheels of various diameters within the diametric range allowed by the frame, and as such is capable of accommodating wheels of differing diameters based on desired terrain usage, as best understood from the claim recitation.

### **Conclusion**

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. De Sarro (US 3,387,852), Ben-Dor et al. (US 4,273,345), Horibata (US 5,127,672), Walin (US 5,308,093), Brandner (US 5,570,894), Lu (US 5,741,019), Bott (US 5,829,758), Soo (US 6,056,299), Bain (US 6,145,852), and Walker IV (US 6,209,894) teach skate structures of pertinence.

### **Guidelines for a Proper Response to an Office Action**

The Applicant must reply to the Office Action and may request reconsideration, with or without amendment. In order to be entitled to reconsideration, the Applicant must make a request for reconsideration in writing.

The Applicant must distinctly and specifically point out the supposed errors in the Office Action, and must respond to every objection and rejection in the Action. If the examiner has rejected a claim over prior art, a general allegation that the claim is patentable without specifically pointing out how the material in the claim patentably distinguishes from the prior art references would not be sufficient.

In all cases where the examiner has indicated that a response to a requirement is necessary, or where the examiner has indicated patentable subject matter, the Applicant must either comply with the requirement(s) or specifically argue each one that is not complied with.

The following items of information should be prominently displayed on the response to the Office Action:

1. Serial number of the Application
2. Group Art Unit Number (which can be found on the most recent Office Action)
3. Filing Date
4. Name of the Examiner
5. Title of the invention

A proper response to an Office action should include:

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- a. Instructions to cancel or amend the rejected claims or to substitute or add claims to be considered by this office. Applicant may cancel claims, amend currently pending claims, and/or add new claims beginning with the first available numeral after the last pending claim-- if an application includes claims 1-17, the first new added claim would be claim 18, also note that this condition would hold even if any or all of claims 1-17 had been canceled-- in general, claim numbers are not re-used), and/or
- b. Acknowledgment of objections to the Specification, claims and/or drawings by:
  1. Specific instructions to correct defects in the specification, abstract and claims,
  2. Submitting proposed drawing corrections for the approval of the examiner  
(A proposed drawing correction is made by including a copy of the original figure, with changes made to overcome the objections, and with these changes from the original highlighted in red ink), and/or
- c. An argument or comments under the heading "Remarks" in which applicant points out wherein he/she may disagree with the examiner's contentions (i.e., the objections and/or rejections) and wherein he/she also discusses the references applied against the claims, explaining how the applicant's claims avoid these references or distinguish from them in a patentable sense. This discussion may describe the structural elements which are explicitly set forth in applicant's claims, but which are not shown in the references, or it may describe functions specifically set forth in applicant's claims but which are not shown or discussed in the references.

#### **Timely filing of an amendment**

In general, applicant is given 3 months from the mailing date of an Office action to respond to the office action. Extensions of time of 1, 2, and 3 months may be had beyond the 3 month time period set in the office action, when accompanied by the payment of an extension of time fee under 37 CFR 1.17.

Current fees may be researched on the USPTO's web site, at:

<http://www.uspto.gov/web/offices/ac/qs/ope/fees.htm>

If a communication is deposited with the U.S. Postal Service and mailed to the Office by First Class Mail before the reply time has expired, applicant may submit the reply with a "Certificate of Mailing" which asserts that the reply is being mailed on a given date. So mailed, before the period for reply has expired, the reply may be considered timely. A suggested format for a certificate follows:

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to:

Mail Stop \_\_\_\_\_ (the appropriate mail stop being filled in here)  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450  
on \_\_\_\_\_ (date).

Typed or printed name of person signing this certificate

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Signature \_\_\_\_\_

Date \_\_\_\_\_

**Obtaining the Assistance of the Examiner in Drafting an Allowable Claim  
for Pro-Se inventors**

As specifically referred to in MPEP (the Manual of Patent Examining Procedure) section 707.07(j), when, during the examination of a pro se application it becomes apparent to the examiner that there is patentable subject matter disclosed in the application, the examiner should draft one or more claims for the applicant and indicate in his or her action that such claims would be allowed if incorporated in the application by amendment.

This practice will expedite prosecution and offer a service to individual inventors not represented by a registered patent attorney or agent. Although this practice may be desirable and is permissible in any case deemed appropriate by the examiner, it will be

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expected to be applied in all cases where it is apparent that the applicant is unfamiliar with the proper preparation and prosecution of patent applications.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 703-308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is 703-308-1113.

As of May 1, 2003, any response to this action should be mailed to:

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to the Office-wide central fax:

703-872-9306

The previously used fax numbers may still be used:

703-305-3597; 703-305-7687;

although they now connect to the central fax location.

F. VANAMAN  
Primary Examiner  
Art Unit 3618

  
9/16/03